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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/812,457

03/30/2004

James Matthew Hitch

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7590
Robert D. Touslee
Johns Manville
10100 West Ute Avenue
Littleton, CO 80127

11/27/2007

EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

11/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/812,457
Filing Date: March 30, 2004
Appellant(s): HITCH, JAMES MATTHEW

Robert Touslee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/27/077 appealing from the Office action
mailed 3/30/06

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

NEW GROUND(S) OF REJECTION

Claims 1-8, 14 and 15 are rejected under 35 U.S.C. 103(a) as unpatentable over Peng et al, U.S. Patent Application Publication No. 2003/0054714.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 102(b) rejection of claims 1-8, 14 and 15 over Peng et al, U.S. Patent Application Publication No. 2003/0054714.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2003/0054714

Peng et al

3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-8, 14-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the limitation that "about 25 to about 50 wt. percent fibers having a length of less than about 0.4 inch long and about 75 to about 50 wt. percent fibers having a length at least about 0.45 inch long". The specification provides support for a major portion of the fiber being at least about 0.45 inches long and a minor portion of the fiber being shorter than about 0.4 inches, and also provides support for 75 wt. percent fiber being at least about 0.45 inches long and about 25 wt. percent being about 0.2 inches long.

Claims 1-8, 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the recitation that the mat has "a reduced

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amount of “stand up fibers” renders the claim vague and indefinite because it is not clear to what the mat is being compared to, i.e., reduced as compared to what?

New Grounds of Rejection:

Claims 1-8, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng et al, U.S. Patent Publication 2003/0054714. Peng discloses a fiber mat of improved tear strength comprising fibers having two different lengths. The mat can comprise a mixture of fibers where from about 0 to about 100 wt. % of the fibers have an average length of from about 0.5 to 60 mm which corresponds to 0.019-2.36 inches and about 0 to about 100 wt. % of the fibers having an average length of from about 10 to about 150mm which corresponds to 0.393-5.9 inches and wherein more preferably, the nonwoven comprises about 20-to about 80 wt. % of fibers having an average length of from about 10 to about 45 mm which corresponds to 0.393 – 1.7 inches and from about 20 to about 80 weight % of the fibers have an average length of from about 30-about 80 mm which corresponds to about 1.18-3.14 inches. These values encompass the claimed ranges and amounts of fiber length. See paragraph 0019. The fibers can have a diameter of 1-100 microns with 5-25 microns being more highly preferred. See paragraph 0019. The binder is present in an amount of 5-50 weight %. See paragraph 0017. Suitable binders include those claimed. See paragraph 0022-0025. The nonwoven fiber mat can have asphalt layers applied to its surface, which corresponds to the at least one different layer claimed in claim 5. See paragraph 0017 and 0027.

While the ranges set forth in Peng encompass the claimed ranges, Peng does not set explicitly set forth the particularly claimed ranges and proportions, although

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Peng does broadly encompass all the claimed ranges and proportions. However, Peng et al teaches that the use of two different fiber lengths, wherein the lengths and proportion are selected as taught in paragraph 0019, results in a mat having improved tear strength. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected the optimum lengths and proportions from the ranges broadly disclosed by Peng through the process of routine experimentation, motivated by the expectation of producing a nonwoven mat having optimum tear resistance.

(10) Response to Argument

With regard to the 112 1st paragraph rejection, Appellant argues that the claims are to be read in light of the specification and that it is well established that a major portion in a system made up of two portions, means that one portion is greater in quantity than the other portion. The examiner agrees with this statement, but the issue is not what is meant by greater or lesser portion, but rather whether there is support in the specification for the particular ranges set forth in the independent claims of “about 25 to about 50 wt. percent fibers having a length of less than about 0.4 inch long and about 75 to about 50 wt. percent fibers having a length at least about 0.45 inch long”. The claims do not recite a greater portion having a length of at least about 0.45 and a lesser portion having a length of less than about 0.4 inches, but instead recite a range of 25-50 wt percent having a length of less than 0.4 inches and 75-50 wt percent having a length of at least about 0.45. The specification provides support for a major portion of

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the fiber being at least about 0.45 inches long and a minor portion of the fiber being shorter than about 0.4 inches, and also provides support for 75 wt. percent of the fibers being at least about 0.45 inches long and about 25 wt. percent being about 0.2 inches long, but does not provide support for the limitations set forth in the independent claims.

With regard to the 112 2nd paragraph rejection, Appellant argues that the specification explains the shortcomings of prior art mats regarding stand up fibers and the examples include a representative prior art mat. However, the claims do not compare the claimed invention to a particular mat, but instead recite that the amount of stand up fibers are reduced. The term “reduced” implies comparison but it is not clear to what the claimed invention is being compared. Further, it is not clear what value of stand up fibers would be a reduced amount and therefore the scope of the claims is not clear.

With respect to the arguments regarding the 102(b) rejection over Peng et al, these arguments are moot in view of the new grounds of rejection set forth above.

With respect to the arguments regarding the 103(a) rejection over Peng et al, Appellant argues that the examples of Peng et al teach fibers that are at least one inch long. However, the teachings of Peng are not limited to what is shown in the examples. Peng teaches using two different lengths of fibers to form a glass mat. Peng teaches lengths and diameters which overlap the claimed ranges. Peng teaches that such glass mats can be coated. Peng teaches that using two different lengths of fibers produces a mat having improved tear strength. Therefore, Peng teaches that the fiber lengths are a result effective variable which are related to tear strength. Therefore, it would have

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been obvious to one of ordinary skill in the art at the time the invention was made to have optimized the particular lengths and proportions selected. With regard to the argument that Peng's invention has a different use, the instant claims are drawn to a nonwoven fiber mat, not to a use of the mat. Further, tear resistance is a desirable property in any fabric. Finally, it is not necessary that the motivation found in the reference be the same as applicant's motivation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Elizabeth M. Cole/

Primary Examiner, Art Unit 1794

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Jennifer Michener/

Quality Assurance Specialist, TC1700

Conferees:

/Callie Shosho/

Callie Shosho
Supervisory Patent Examiner
TC 1700, AU 1794

/Jennifer Michener/

Quality Assurance Specialist, TC1700



Jennifer Michener